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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/500,496

03/15/2005

Georg Ignatius

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28107

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08/25/2006

JORDAN AND HAMBURG LLP

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SUITE 4000

NEW YORK, NY 10168

EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 08/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/500,496

Applicant(s)

IGNATIUS, GEORG

Examiner

William M. Pierce

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

WILLIAM M. PIERCE
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

Claims 1-24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. ***

"one-dimensional" regions are not discussed in detail. While mentioned in the middle of pg. 2 of the specification, it is not mention in such a way that one can make or use applicant's claimed invention.

Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is unclear in that there exists no clear transitional phrase such that one can discern between the preamble and the body of the claim. It appears that the claim positively recites "the play object" on ln. 3. It is unclear if it is being recited as necessary to the claimed combination of the invention. "and/or" renders the claim indefinite and beyond the scope of the claimed invention. The specification does not disclose a "plurality" of singular three-dimensional and two-dimensional and one dimensional regions on an impacting instrument. The term "especially" renders the claim indefinite. The term "ordered series" is not used in the specification such that one can determine the scope and meaning as used in the claim. In claim 5, "the volume" and "the solid body" lacks a proper antecedent. In claim 6, "strip-like" renders the claims indefinite. In claim 7, "the mutual edge", "the sequence direction" lack a proper antecedent, "and/or is indefinite, and a "vibrationally active organization" and "characteristic vibrations results" are unclear in that one cannot determine the metes and bounds of the claim. In claim 8, "and/or is indefinite" and the metes and bounds of "vibrationally-relevant parameters" is unclear. In claim 10, "especially" renders the claim indefinite. Claim 13 is inept such that one cannot determine the metes and bounds for the claim. "Especially" and "and/or" renders the claim indefinite and "extending superimposition structure of a majority" has no clear metes and bounds. In claims 15 and 16, "the value", "the distribution" and "the mutually superimposed sequences" lack a proper antecedent. "and/or" renders the claim indefinite. Additionally to claim 16, "the consecutively following singular regions" lacks a proper antecedent. In claim 21, "and/or" render it indefinite.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 6, 7-21 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Wright et al.

6,431,996.

As to claim 1, Wright shows an instrument such as a club with a plurality of regions 306, 302, 308, 310, 304, 312 and 314 of different material col. 9, ln. 56+ and corresponds to a series as shown in figs. 2-4. As to claim 3, Wright shows region 306 in the handle. As to claim 6, the regions of Wright are considered strip like in that they are "located along the shaft" (abstract, ln. 4) like would be a strip. As to claims 7, 8 and 11 the distances between the centers of the sectional regions as shown in fig. 8 are dimensional with an active organization or characteristic results as shown in the graph provided with the figure that shows a sequence with vibrationally-relevant parameters. As to claims 9 and 12, the regions in fig. 8 are vibrationally varying as shown by the fluctuations in the graph provided. As to claim 10, the sequence shown in fig. 8 varies statistically by a random generator such as the instruments 54 and 56. As to claims 13-19 the seven regions of Wright in fig. 8 show a vibrationally active organization superimposed on the structure of the shaft at a plurality of different intervals that are approximately equally distant as shown by 308 and 310 according to a harmonic series as shown in figs. 2-4. As to claims 20 and 21 the regions of metal are along the edge of the shaft.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 2, 4, 5, 22 and 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wright in view of Leon 5,707,302 and further in view of Yamaguchi 4,928,965.

As to claims 2 and 4, Wright is only concerned with handling the vibration associated with the shaft. It is well known to employ methods to handle vibration in the impact part such as in the head such as taught by Leon. To

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have included to have provided elastomer material on the impact region of Wright would have been obvious in order to minimize vibration. As to claim 5, 11 is considered to be volume of a solid body. As to claims 22 and 24 the applications of vibration modification techniques from one type of sport device to another is well known. See Yamaguchi 4,928,965 who teaches that such designing techniques can be used on a bat, club, racket or paddle for an example.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Vincent, Martuch, Gibson, McCoy, Yamaguchi, Tousey, Crow, Hwang, Marcelo, Harada, Chien, Lai, Morrell, Simmons, Veux, Hedrick, Wright, Fujii and Collinson shows impact drivers with vibration management designs.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Pierce whose telephone number is 571-272-4414 and E-mail address is bill.pierce@USPTO.gov. The examiner can normally be reached on Monday and Friday 9:00 to 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



**WILLIAM M. PIERCE
PRIMARY EXAMINER**